<div align="center">

REMARKS

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SPECIAL STATUS

Applicant notes that this application has been pending for more than five years. Accordingly, the application is now entitled to special status as set forth in MPEP 708.

SECTION 103 REJECTIONS

Applicant appreciates the withdrawal of the section 103 rejection based on the three-way combination of *Soltis*, *Williams*, and allegedly admitted prior art.

A careful inspection of *Williams* suggests that *Williams* is not, in fact, prior art.

Specifically, page 2 of *Williams* refers to revisions that were made on November 8, 1999. Therefore, *Williams* could not have been published until at least after November 8, 1999. Since November 8, 1999 is later than the October 5, 1999 priority date of this application, it follows that *Williams* must be disqualified as prior art.

Applicant notes that the IDS filed with the application on October 4, 2000 states that *Williams* was published on May 10, 1999. However, a close inspection of *Williams* reveals that this date cannot possibly be correct. Page 2 of *Williams* refers to activities that occurred on July 2, 1000, October 18, 1999, and November 8, 1999, all of which are later than May 10, 1999.

Since the section 103 rejections all rely on *Williams*, Applicant submits that they are all improper and requests their withdrawal.

CLAIM AMENDMENTS

The Examiner objects to the use of pronouns in claims. In response, Applicant amends claim 2 to avoid the use of "its." Applicant is unable to find the word "its" anywhere else in the claims.

SECTION 112 PARAGRAPH 2 REJECTION

MPEP 2171 requires that a rejection under section 112 paragraph 2 set forth whether the rejection is based on Applicant's failure to provide "one or more claims particularly pointing out

and distinctly claiming the subject matter" or whether the rejection is based on Applicant's failure to claim "subject matter which the applicant regards as his invention."

The Examiner does not specify which of these are relevant. However, judging from the Examiner's remarks, both are regarded as relevant. Accordingly, Applicant addresses each in turn.

"…particularly pointing out and distinctly claiming…"
In rejecting the claims under 35 USC 112, the Examiner refers to claim 1's recitation:

> wherein the formal description of the file system enables said client to find and interpret at least one data structure that includes file information that enables the client to directly read and write data to and from said disk storage, block allocation for the data being performed by the server, and wherein the formal description of the file system lacks a data structure that includes file information

The Examiner suggests that the foregoing claim language makes it unclear "whether the formal description is designed to include both a data structure and a non-data structure."[1]

Applicant is unsure what exactly is meant by a "non-data structure." In an effort to better address the Examiner's concern, Applicant requests that the Examiner define or provide examples of a "non-data structure."

Without knowing exactly what a "non-data structure" might be, and based only on the Examiner's remarks, Applicant suspects that perhaps the Examiner considers there to be a contradiction between a first passage:

> "wherein the formal description … enables said client to find and interpret at least one data structure that includes file information"

and a second passage:

> wherein the formal description … lacks a data structure that includes file

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[1] *Office Action*, Aug. 23, 2006, page 2

information

In fact, there is no contradiction at all. The first passage places a limitation on what the formal description *does*, and the second passage places a limitation on what the formal description *has*. There is no inconsistency between the first and second passages.

According to the first passage, a client who reads the formal description will be able to find and interpret a data structure. This data structure will include certain file information.

According to the second passage, the formal description does not include the data structure. The formal description merely provides the client with whatever it needs to find and interpret this data structure. The data structure itself is elsewhere. This does not contradict the first passage.

It may be helpful, in understanding the claimed invention, to consider an analogy in which a telephone book is a "data structure." The telephone listings, which include names, addresses, and numbers, could then be viewed as "file information." In that case, one would have a "data structure that includes file information."

The ability to actually use a telephone book requires some background knowledge. For example, one would first need to know where to find the telephone book. Then, after having found the telephone book, one would need to know how to interpret it. These two items of information would be part of a "formal description" of the telephone book. Such a formal description would enable one to "find and interpret at least one data structure [i.e. the telephone book] that includes file information [i.e. the listings]."

Note that the instructions for how to interpret a telephone book are far from trivial. One would have to know, for example, that listings are ordered alphabetically by last name, that the roman alphabet is used, that a comma will separate the first name from the last name, that in the case of the same last name, the first name functions as a tiebreaker, that the telephone number appears at the end of the lasting, and that numbers are shown without area codes. One might also

need to know that there exists a second portion of the telephone book (yellow pages) in which listings are organized by category, and that there may be a third portion (blue pages) that lists the categories used in the second portion. One would also have to know that for certain telephone books, there are portions that include maps, or descriptions of local attractions, and that there may be pages with tear-off coupons.

All of these formal features of a telephone book, which we take for granted, do not represent the only possible way to organize a telephone book. Telephone books vary from one country to the next, and in some cases, from one city to the next. For example, Russian telephone books would most likely use a Cyrillic alphabet.

In fact, one need not travel outside the country to see variety in telephone book organization. For instance, certain institutions may publish telephone books that contain listings for employees and/or students. These telephone books may be organized quite differently from the public telephone books published by telephone companies.

These and other formal features of a telephone book must be set forth someplace so that one who finds such a telephone book would know how to use it. There are only two places one can place the formal description of a telephone book: (1) as part of the telephone book itself; and (2) separate from the telephone book.

In case (1), one would have "a formal description of the file system that includes a data structure that includes the file information." In case (2), one would have the opposite, namely "a formal description of the file system that lacks a data structure that includes the file information."

The claims are directed to the latter case. A client reads information (i.e. a "formal description") that enables him to find a telephone book and to understand how that telephone book is organized. But this information that the client reads does not itself include the telephone book.

In fact, it would be a bit odd for the client to read information that enables him to find the telephone book, and to require that this information also be part of the telephone book. This would create something of a "catch 22": the client would have to find the telephone book before he could read the information needed to find it.

In the same way, in claim 1, it would be a bit odd for the client to read a formal description that "enables said client to find...[a] data structure that includes file information" and to then require that the formal description already include that data structure. It is to avoid the resulting "catch 22" that the claim also requires that "the formal description...lacks a data structure that includes file information."

Applicant acknowledges the Examiner's suggestion to amend the claim to recite attaching a client to a network file system instead of a file system. Applicant is unsure what significance this amendment would have, since a network file system is already a species of a file system.

"...subject matter which applicant regards as his invention."
The Examiner also states that "[t]he invention as claimed is teaching away from the purpose of the invention" because "[t]he claimed invention is not directed to a self-describing file system."[2]

Consistent with section 112, paragraph 2, claim 1 sets forth what Applicant regards as his invention. The Examiner appears to be stating that the true invention is something other than what Applicant regards as his invention.

Section 112 paragraph 2 requires that the claims set forth what *Applicant* regards as the invention, not what the *Examiner* regards as the invention. By definition, the claims cannot teach away from what *Applicant* regards as the invention because the claims actually *define* what Applicant regards as the invention.

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[2] *Office Action*, Aug. 23, 2006, page 3

The invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which Applicant regards as his invention.[3] The Examiner has not identified any evidence to suggest that the claims are anything but what Applicant subjectively regards as the invention. Accordingly, there is no legal basis for a rejection under section 112 paragraph 2.

SECTION 112 FIRST PARAGRAPH (WRITTEN DESCRIPTION)

The Examiner suggests that there exists a lack of support for a formal description that lacks a data structure that includes file information.

Applicant draws attention to page 11, lines 13-27, page 12, lines 17-18, originally filed claim 1, and FIGS. 6 and 7, all of which collectively combine to provide such support.

For example, page 11, lines 23-25 state that the client, having read the formal description can determine the blocks to access when reading or writing a file. However, the client cannot perform block allocation and file serialization. These functions are carried out by the server.

It is apparent from the foregoing that the formal description read by the client does not have sufficient information to allow the client to carry out these functions. Such information would normally be in the "data structure that includes file information." Therefore, the data structure that includes file information could not have been read by the client.

SECTION 112 FIRST PARAGRAPH (ENABLEMENT)

Applicant draws attention to FIGS. 6 and 7, and the accompanying description in the specification. FIGS. 6 and 7 collectively show a formal description of a file system. The formal description does not include a data structure that includes file information.

Applicant submits that FIGS. 6 and 7, together with the accompanying description thereof, provide enablement for the claimed subject matter.

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[3] *In re Moore*, 439 F.2d 1232 (CCPA 1971); MPEP 2172.

SUMMARY

The fact that only certain arguments have been advanced or that only certain claims have been discussed is not intended to be an admission that no other arguments exist, or that those claims not specifically discussed are unpatentable.

Now pending in this application are claims 1-3, 6-9, 16-27, and 33-40. Of these, claims 1, 16, 20, and 25.
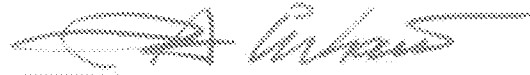
No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050 referencing attorney docket 07072-133001.

Respectfully submitted,

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